



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/821,180	04/09/2004	Jean-Luc Bouthemy	59643.00436	8414
32294 7590 07/02/2007 SQUIRE, SANDERS & DEMPSEY L.L.P. 14TH FLOOR 8000 TOWERS CRESCENT TYSONS CORNER, VA 22182			EXAMINER JACKSON, BLANE J	
			ART UNIT 2618	PAPER NUMBER
			MAIL DATE 07/02/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

10/821,180

Applicant(s)

BOUTHEMY ET AL.

Examiner

Blane J. Jackson

Art Unit

2618

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 09 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7-14 and 16-21 is/are rejected.
- 7) ☒ Claim(s) 6 and 15 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Information Disclosure Statement***

The Information Disclosure statement filed 18 November 2004 is made of record.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5, 7, 9-14, 16 and 18-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pecen et al. (US 6,631,259) in view of Bourdeaut et al. (US 2004/0203775).

As to claims 1 and 10, Pecen teaches a system comprising user equipment for use in an access network, the user equipment arranged to enable a plurality of access network applications to run (each mobile station in a GSM system identified for the capability of a dual transfer mode for simultaneous services or network applications, figure 1, column 2, line 38 to column 3, line 25), but is silent as to the user equipment comprising a user identification module to enable a plurality of access network applications.

Bourdeaut teaches a GSM/UMTS dual mode mobile terminal that utilizes a user identification module in the form of an SIM/USIM card to identify to the local network, a

Art Unit: 2618

plurality of allowed circuit switched and packet switched services with respect to a plurality of second and third generation radio access networks, paragraphs 0018, 0023 and 0046-0088.

Since Bourdeaut directly teaches the application of the user identification module in the mobile terminal operating in a GSM/ UMTS system, it would have been obvious to one of ordinary skill in the art at the time of the invention to recognize in the GSM/ GPRS cellular system of Pecen the application of a SIM/ USIM card in the system of Bourdeaut to identify allowed services and mobile telephone capabilities that correspond to different radio access technologies.

As to claims 2 and 11 with respect to claims 1 and 10, Pecen teaches the plurality of access network applications run in parallel (column 4, lines 33-51, a mobile station equipped to handle simultaneous circuit switched GSM voice and packet switched data transmission).

As to claims 3 and 12 with respect to claims 1 and 10, Pecen of Pecen modified teaches the module is arranged to enable at least one core network application to run and wherein said module is arranged to enable said core network application to run in parallel with at least one of said plurality of access network applications (figure 1, column 4, lines 33-51, GSM access network with voice call and data transmission from the packet data (114) or core network).

As to claims 4 and 13 with respect to claims 3 and 12, Pecen of Pecen modified teaches the user identification module is arranged to generate authentication data for the core network and the access network wherein the authentication data for the core network and for the access network is further arranged to be dependent on a common data set (column 2, line 60 to column 3, line 25, the SGSN (112) keeps track of the location of the mobile station and performs security functions and access control, access control dependent on determining if the mobile station is capable of operating in a dual transfer mode as identified by the user identification module).

As to claims 5 and 14 with respect to claims 4 and 13, Pecen of Pecen modified teaches the common data set comprises data for use in encryption (column 2, line 60 to column 3, line 7, the SGSN performs security functions which inherently includes the use of encryption of the capability data of the mobile terminal).

As to claim 7 with respect to claim 1, Pecen teaches the access network comprises at least one of a CDMA2000 network, a UMTS network, a IEEE802.11 network, a DAMPS network, a AMPS network and a WCDMA network (figure 1, column 2, lines 38-65, a GSM network).

As to claim 9, Bourdeaut of Pecen modified teaches the module comprising a Universal Integrated Circuit Card (paragraph 0086, the allowed services list stored in a Subscriber Identity module/Universal Subscriber Identity Module (SIM/USIM) card).

As to claim 19, Pecen teaches a method for operating user equipment for use in an access network comprising the step of enabling a plurality of access network applications to run (figure 1, column 4, lines 33-51, simultaneous voice and data transmission in a mobile telephone capable of a dual transfer mode), but is silent as to the user equipment comprising a user identification module to enable a plurality of access network applications.

Bourdeaut teaches a GSM/UMTS dual mode mobile terminal that utilizes a user identification module in the form of an SIM/USIM card to identify to the local network, a plurality of allowed circuit switched and packet switched services with respect to a plurality of second and third generation radio access networks, paragraphs 0018, 0023 and 0046-0088.

Since Bourdeaut directly teaches the application of the user identification module in the mobile terminal operating in a GSM/ UMTS system, it would have been obvious to one of ordinary skill in the art at the time of the invention to recognize in the GSM/ GPRS cellular system of Pecen the application of a SIM/ USIM card in the system of Bourdeaut to identify allowed services and mobile telephone capabilities that correspond to different radio access technologies.

As to claim 20 with respect to claim 19, Pecen teaches the step of enabling a plurality of access network applications to run comprises:

Art Unit: 2618

Enabling a first access network application to run (column 3, lines 26-46, circuit-switched voice activity),

Enabling a second access network application to run (column 4, lines 16-51),

Wherein the first and second access network applications are enabled to run in parallel (column 4, lines 33-45, simultaneous voice and data transmission in dual transfer mode).

As to claim 20 with respect to claim 19, Pecen teaches the step of enabling at least one core network application to run wherein the said step of enabling a plurality of access network applications and the step of enabling at least one core network to run are arranged to enable the at least one core network application to run in parallel with at least one of the plurality of access network applications (column 4, lines 33-51, enabling a dual transfer mode of a 3G type data transmission and voice communication).

Claims 8 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pecen et al. (US 6,631,259) and Bourdeaut et al. (US 2004/0203775) in view of Ejzak (US 6,871,070).

Pecen teaches a 3G wireless system comprising a circuit switched and packet switched data networks, figure 1, column 2, lines 38-59 but does not teach an Internet Protocol multimedia subsystem (IMS).

Ejzak teaches a 3GPP communication system including user equipment (111), radio access network (RAN), packet-switched domain (131), circuit-switched domain

(131) and IP Multimedia Subsystem (IMS) (141), figure 1, column 2, line 66 to column 3, line 35. Ejzak teaches the IMS is made available for mobile units using either circuit-switched or IP Multimedia call control procedures, figure 1, column 1, line 56 to column 2, line 40.

It would have been obvious to one of ordinary skill in the art at the time of the invention to recognize the 3G system of Pecen to include the IP Multimedia Subsystem of Ejzak to provide internet-like functionality and services to mobile units along with voice and data services.

#### ***Allowable Subject Matter***

Claims 6 and 15 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### ***Conclusion***

The prior art made of record and not relied upon but considered pertinent to applicant's disclosure includes: Sharman (USSIR H1641), Gupta et al. (US 6,567,667) and Pecen et al. (US 6,714,781).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Blane J. Jackson whose telephone number is (571) 272-

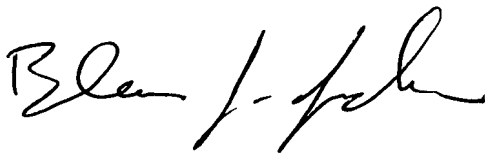


Art Unit: 2618

7890. The examiner can normally be reached on Monday through Thursday, 7:30 AM-6:00 PM, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Urban can be reached on (571) 272-7899. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A handwritten signature in black ink, appearing to read "Brian J. Felt". The signature is fluid and cursive, with the first name "Brian" being more legible than the last name "Felt".